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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,216	04/13/2004	Ronan Rogers	P1481 CIP (2650/148)	4655

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EXAMINER

MENDOZA, MICHAEL G

ART UNIT PAPER NUMBER

3731

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/823,216	Applicant(s) ROGERS ET AL.	
	Examiner Michael G. Mendoza	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11-15 and 17-22 is/are rejected.
- 7) ☒ Claim(s) 8-10 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>13 April 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. Claims 1-7, 12, 15, 17, 18, and 20-22 of this application conflict with claims 1-14 of Application No. 10/418,457. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1-7, 12, 15, 17, 18, and 20-22 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-14 of copending Application No. 10/418,457. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 5, 6, 12, 13, 15, and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Yan 6066156.

6. Yan teaches an apparatus and method of manufacturing a system for treating a vascular condition, comprising: providing a catheter, the catheter including an inflatable balloon; positioning a stent over the balloon; applying an adhesive material between an inner surface of the stent and an outer surface of the balloon; heating the adhesive material to above a melting point of the adhesive material; and cooling the adhesive material to below a melting point of the adhesive material to provide an adhesive bond that retains the stent to the catheter during vascular delivery, wherein the stent is released from the balloon following inflation and deflation of the balloon at a treatment site (see abstract); wherein the stent is formed with openings in its walls (fig. 1); wherein the adhesive material comprises a biocompatible material having a melting point below approximately one hundred sixty-six degrees Fahrenheit (col. 3, lines 60-64); further comprising first minimizing the balloon profile prior to positioning the stent over the balloon (col. 4, lines 3-6); dispersing the adhesive material throughout a fluid prior to application of the adhesive material (col. 4, line 5); positioning a sheath over the stent prior to application of the adhesive material; wherein applying an adhesive material between an inner surface of the stent and an outer surface of the balloon comprises introducing the adhesive material within the sheath such that the adhesive material flows between the inner surface of the stent and the outer surface of the balloon (col. 4,

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lines 60-67); furthering comprising crimping the stent onto the balloon prior to heating the adhesive material (col. 6, lines 41-48); and maintaining the balloon in a partially inflated configuration while heating and cooling the adhesive material (figs. 1 & 3).

7. As to claim 18-19, the claims are product-by-process claims. A product-by-process must result in a structural difference to read over the prior art. Yan teaches all of the structural limitations of claim 15-16. Therefore, the system of Yan is fully capable of being heated at a temperature of approximately one hundred sixty-five degrees Fahrenheit; and being heated for a time duration of approximately three minutes.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yan 6066156 in further view of Phan et al.

10. As to claim 4, Yan fails to teach wherein the adhesive material comprises polyethylene oxide. However, it is known to use polyethylene oxide as a biocompatible adhesive on stents as evidenced by US Patent 5674242 to Phan et al. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use polyethylene oxide to provide a biocompatible water soluble adhesive that allows release of the stent in the presents of water (col. 10, lines 23-39)

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11. As to claim 14, Phan et al. discloses the claimed method except for wherein the sheath comprises a plurality of tubular members. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a sheath comprising a plurality of tubular members, sine it has been held that mere duplication of an essential working part of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Allowable Subject Matter

12. Claims 8-10 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael G. Mendoza whose telephone number is (703) 305-3285. The examiner can normally be reached on Mon.-Fri. 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Dawson can be reached on (703) 308-4304. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



MM
September 9, 2004



GLENN K. DAWSON
PRIMARY EXAMINER